

Attorney Ref. No. 012.P53013

Patent Application No. 09/918,691

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REMARKS

This response is a full and complete response to the non-final Office Action mailed May 21, 2007. In the present Office Action, the Examiner has noted that claims 1-41 are pending, that claims 1-15 and 30-41 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,785,290 to Fujisawa et al. (hereinafter "Fujisawa"), that claims 16-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of Fujisawa, U.S. Patent No. 6,049,550 to Baydar et al. (hereinafter "Baydar"), U.S. Publ. No. 2003/0081287 to Jannson et al. (hereinafter "Jannson").

In view of both the amendments presented above and the following remarks, it is submitted that the claims pending in the application are novel and nonobvious. It is believed that this application is in condition for allowance. By this response, reconsideration of the present application is respectfully requested.

Claim Amendments:

The assignee has amended claims 8 and 11-13 to correct typographical errors and claims 39 and 41 to combine limitations of these claims. Claims 1, 8, 11, 16, and 23 have been amended to add the word "structurally". Claims 30, 33, 36, and 39 have been amended to include the word "exactly". The assignee has not introduced any limitations that have not already been examined. Thus, the claim amendments do not necessitate a new search.

Claim Objections:

The Examiner objects to claim 11 because "egress packets" should be replaced with "ingress packets". There is also an extra comma in claim 11.

Attorney Ref. No. 012.P53013

Patent Application No. 09/918,691

The assignee has amended claim 11 to overcome the claim objections by changing "egress packets" with "ingress packets" in line 11, and removing the extra comma in line 17.

Claim Rejections Under 35 U.S.C § 102(e)

Claims 1-15 and 30-41 are rejected as being anticipated by Fujisawa. This rejection is respectfully traversed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP § 2131 citing *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Fujisawa does not teach each and every element of the rejected claims.

To expedite examination of the claims towards allowance, the assignee has amended claims 1, 8, and 11 to recite an egress/ingress undiverted packet buffer structurally coupled between the first packet diversion logic and the first packet insertion logic. Support for this amendment may be found in the Specification, for example, in FIG. 3 and its supporting text.

The Examiner rejected these claims by asserting that the first packet diversion logic and the first packet insertion logic read on Fujisawa's scheduler 16, that the egress/ingress undiverted packet buffer reads on Fujisawa's cell buffer 56/66, and that, even though the cell buffer 56 is not structurally coupled between the first packet diversion logic and the first packet insertion logic, it is functionally coupled between these elements (see the Examiner's *Response to Arguments*, page 22).

Attorney Ref. No. 012.P53013

Patent Application No. 09/918,691

The amended claims, however, now include the *structurally coupled between* limitation that the Examiner pointed out to not be taught by Fujisawa.

For at least the reasons discussed above, Fujisawa fails to anticipate claims 1-15. Thus, the assignee respectfully requests withdrawal of the rejection for these claims.

Claims 30, 33, and 36 recite a first divert logic coupled to said first and second storage structures to selectively route egress/ingress packets onto a selected exactly one of said first and second storage structures. Claim 39 has been amended with limitations from claim 41 to also include limitations similar to those of claims 30, 33 and 36.

The Examiner rejects claims 30, 33, and 36 by asserting that Fujisawa teaches selective routing onto a selected one of the first storage structure 56 and the second storage structure 44A. But, as Fujisawa teaches in FIG. 8D, cell buffer 56 and temporary RAM 44A are serially connected, and data packets cannot be routed onto temporary RAM 44A without first being routed onto cell buffer 56. Because, each of the claims 30, 33, 36, and 39 require routing onto a selected *exactly one* of the storage structures, Fujisawa fails to anticipate these claims by only being able to route data packets onto *both* cell buffer 56 and temporary RAM 44A.

For at least the reasons discussed above, Fujisawa fails to anticipate claims 30-41. Thus, the assignee respectfully requests withdrawal of the rejection for these claims.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 16-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Fujisawa, Baydar, and Jannson.

Attorney Ref. No. 012.P53013

Patent Application No. 09/918,691

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on [Applicant's] disclosure." MPEP § 2143. Assignee respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

The assignee has amended claims 16 and 23 to recite an egress undiverted packet buffer structurally coupled between the first packet diversion logic and the first packet insertion logic. Fujisawa fails to teach, show, or make obvious these limitations, as discussed above regarding claims 1, 8, and 11. Baydar and Jansson fail to make up for Fujisawa's shortcomings. Thus, the assignee submits that these references, individually or in combination, do not teach or suggest all the limitations of the aforementioned claims, and respectfully requests withdrawal of the rejection of these claims, as well as their dependent claims 17-22 and 24-29 under 35 USC § 103 (a).

It is noted that claimed subject matter may be patentably distinguished from the applied documents for additional reasons; however, the foregoing is believed to be sufficient to overcome the Examiner's rejections discussed above.

Further, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions since the Examiner's other positions are believed to be moot in light of the foregoing.

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Patent Application No. 09/918,691

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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. Reconsideration and allowance of all the claims are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Brian Wichner at (503) 439-6500 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Attorney Ref. No. 012.P53013

Patent Application No. 09/918,691

In the event that there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3703.

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JUN 27 2007

Respectfully submitted,

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